

### **REMARKS**

The Official Action mailed June 8, 2006, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Filed concurrently herewith is a *Request for Continued Examination*. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on February 17, 2005; March 1, 2005; July 26, 2005; March 21, 2006; and April 4, 2006.

The Applicants again note the partial consideration of the Information Disclosure Statement filed on November 4, 2004 (received by OIPE November 5, 2004). Specifically, it appears that the Examiner inadvertently overlooked the citation of the "European Search Report dated September 3, 2004 for EP 04 00 4257," which is cited in the "OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS" section of the Form PTO-1449. In order to facilitate the Examiner's consideration of the European Search Report, the Applicants previously attached a courtesy copy of the partially considered Form PTO-1449 (in the Image File Wrapper, see the "List of References cited by applicant and considered by examiner" with a Mail Room Date of "03-03-2006" or see page 4 of 4 of the "List of References cited by applicant and considered by examiner" with a Mail Room Date of "12-01-2005"). The Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the European Search Report.

Further, the Applicants still have not received acknowledgment of the Information Disclosure Statement filed on November 2, 2005 (received by OIPE November 4, 2005). The above-referenced Information Disclosure Statement appears in the Image File Wrapper, and consideration of this Information Disclosure Statement is respectfully requested.

A further Information Disclosure Statement is submitted herewith and consideration of this Information Disclosure Statement is respectfully requested.

Claims 7, 8, 10-13 and 15-21 were pending in the present application prior to the above amendment. Claims 7, 8, 12 and 13 have been amended for clarity, and new dependent claims 22-24 have been added to recite additional protection to which the Applicant is entitled. Accordingly, claims 7, 8, 10-13 and 15-24 are now pending in the present application, of which claims 7, 8, 12, 13, 18 and 19 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 7, 8, 10, 12, 13, 15 and 18-20 as anticipated by JP 2001-044120 to Tetsuya OGAWA (the Official Action refers to the reference as "Tetsuya"). The Applicant respectfully traverses the rejection because the Official Action has not established an anticipation rejection.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

The Applicant respectfully submits that an anticipation rejection cannot be maintained against the independent claims of the present application. Independent claims 7, 8, 12, 13, 18 and 19 recite that a first laser beam is a harmonic wave of a solid laser and that a second laser beam has a fundamental wave.

Without any specific references to the disclosure of Tetsuya that establish what features of Tetsuya allegedly correspond with the features of the present claims, the Official Action generally asserts that paragraphs [0012]-[0033] of Tetsuya disclose an apparatus for laser heat treatment including the claimed steps of the present application (pages 2-4, Paper No. 20060509). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

Tetsuya appears to teach that a first pulse laser beam is a laser beam in an ultra-violet region and that a second pulse laser beam is emitted from a Q-switched solid laser with a second or higher harmonic using Nd or Yb ion doped crystal or glass as an excitable medium (see, for example, paragraphs [0012] and [0014]). However, Tetsuya does not teach that a first laser beam is a harmonic wave of a solid laser, or that a second laser beam has a fundamental wave, either explicitly or inherently.

Since Tetsuya does not teach all the elements of the independent claims, either explicitly or inherently, an anticipation rejection cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 102 are in order and respectfully requested.

The Official Action rejects claims 11, 16, 17 and 21 as obvious based on the combination of Tetsuya and U.S. Patent No. 5,304,357 to Sato. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please incorporate the arguments above with respect to the deficiencies in Tetsuya. Sato does not cure the deficiencies in Tetsuya. The Official Action relies on Sato to allegedly teach the features of the dependent claims. Specifically, the Official Action relies on Sato to allegedly teach "a firm formed over a substrate transparent to the first laser beam having a thickness  $d$ , and wherein an incidence angle  $\Phi$  of the first laser beam to the surface to be irradiated satisfies an inequality  $\Phi \geq \arctan(W/2d)$ , when a major axis of the elongated beam or a minor axis of the elongated beam is assumed to have a length of  $W$ " (page 5, Paper No. 20060509). However, Tetsuya and Sato, either alone or in combination, do not teach or suggest the following features or that Tetsuya should be modified to include any of the following features: that a first laser beam is a harmonic wave of a solid laser and that a second laser beam has a fundamental wave.

Since Tetsuya and Sato do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

New dependent claims 22-24 have been added to recite additional protection to which the Applicant is entitled. Claims 22-24 recite that each of a first laser oscillator and a second laser oscillator is a continuous wave solid laser, which is distinguished from the prior art, and which is supported by the present specification, for example, by original claims 9 and 14. The Applicant respectfully submits that new claims 22-24 are in condition for allowance.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert L. Pilaud", written over a horizontal line.

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